

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/043,813 09/29/98 KELLY

M 85010340301

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SEATTLE WA 98104-7092

EXAMINER

GUPTA, A

ART UNIT

PAPER NUMBER

1653

DATE MAILED:

05/09/00

b

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No. 09/043,813	Applicant(s) Kelly et al.
Examiner Anish Gupta	Group Art Unit 1653

Responsive to communication(s) filed on Feb 22, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

Claim(s) 1-6 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-6 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

**DETAILED ACTION**

***Double Patenting***

1. The rejection of claims 5-6 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 34 and 56 of copending Application No. 08/751,300 is hereby withdrawn.

2. Claims 1-4 remain and 5-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 54 and 55 of copending Application No. 08/751,300 for the reasons set forth in the previous office action and the reasons set forth below.

Applicants state that the claims of the pharmaceutical formulation are directed to composition that include various derivatives of the isolated compounds, not the compounds themselves. "Accordingly one would not necessarily need to have the isolated compound in order to produce the pharmaceutical formulations." Applicants then recite synthetic methodology wherein a pharmaceutical composition was obtained without generating the "isolated compound" per se.

Applicant's arguments filed 2-22-00 have been fully considered but they are not persuasive.

It should be noted that claim 54 recites "A pharmaceutical composition comprising a *compound*, derivative or salt of any claims 1-4, 9-12, 25-31, or 34-40 and a pharmaceutically acceptable carrier." Therefore the claim clearly envisions the isolation of the compound to achieve the pharmaceutical formulation and further distinguishes between the compound and its derivatives or salts since the claims recites all three. Accordingly one would necessarily need to have the isolated compound in order to produce the pharmaceutical formulations.

Note that claim 55 also recites the use of "a therapeutically effective amount of a compound" for the treatment of a patient afflicted with a bacterial function. Therefore claim 55 also envisions the use of a compound, in addition to the derivatives and salts to practice the method.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Gupta whose telephone number is (703) 308-4001. If attempts to reach the examiner by telephone are

unsuccessful, the examiner's supervisor, Christopher Low, can normally be reached on (703)308-2923. The fax phone number of this group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Anish Gupta

*Christopher S.F. Low*  
CHRISTOPHER S.F. LOW  
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